REMARKS

In the Office Action, the Examiner indicated that claims 1 through 12 are pending in the application and the Examiner rejected all claims.

Claim Rejections, 35 U.S.C. §102

On page 2 of the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2005/0091101 to Epling et al. ("Epling").

The Present Invention

The present invention discloses an E-Marketplace where parties involved in transactions each identify and submit to the E-marketplace relevant characteristics related to their privacy policy needs (those that they adhere to, referred to as "privacy policies"; those that they require others to adhere to, referred to as "privacy preferences", or both). Typically, this would occur during the registration process when an E-marketplace participant first registers with the E-marketplace, but could be defined per transaction. The privacy policies and privacy preferences of the E-marketplace participants are then matched up, and those with matching characteristics are given access to each other, while those that do not match up are denied access to participating in transactions with each other. This serves as a search filter to match up consumers with providers.

U.S. Patent Application Publication No. 2005/0091101 A1 to Epling et al.

U.S. Patent Application Publication No. 2005/0091101 A1 to Epling et al. ("Epling") teaches a system and a method for determining conflicts between user concerns and a Web site privacy policy. A set of user concerns is compared to the privacy policy to identify any potential problems that might exist for the particular user. If any conflicts are found between the user concerns and the privacy policy, the privacy policy is transformed to provide a user view that emphasizes the concerns that are conflicted. This transformation allows for a negotiation between a consumer and a vendor resulting in a modified set of rules both can agree on. As a result, the user can focus on only the portion(s) of the privacy policy that are of interest to the user (Epling, abstract).

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

As noted above, the present claimed invention focuses on improving security in an E-Marketplace for a consumer. This is accomplished, in part, by determining a consumer's privacy use information, comparing this privacy use information to those of the various vendors of the E-

Marketplace, and only allowing transactions between a consumer and a vendor with matching privacy use information.

Specifically, claim 1 states the limitation of:

> "only allowing transactions to occur between participants who have matching privacy-use information"

Each additional independent claim (claims 5 and 9) state a variation of this limitation.

This limitation is a primary point of divergence between the present invention and the prior art, including Epling. The Examiner notes that "Epling discusses stopping any transactions before they occur if the privacy use information does not match." However, no citation is given to any place in Epling that states Epling only allows transactions to occur between participants who have matching privacy information, as is claimed in the present invention. Epling is concerned with transforming, i.e. modifying, the privacy-use policies to reach a point of agreement where the consumer and vendor can continue on with the transaction. FIG. 2 of Epling illustrates the steps taken when checking the privacy-use information. If there are no conflicts, the process allows the user to continue browsing the site. If there are conflicts, the system continues on with the process, using the transformed data as an indicator of a level of security with which to proceed. Nowhere in Epling is there any discussion of precluding the transaction, and nowhere does Epling suggest only allowing transactions to occur between participants who have matching privacy-use information. In fact, Epling teaches away from this idea by continuing each transaction with a transformed set of privacy-use information. The idea of Epling is for the vendor and consumer to each start with the best deal for themselves, and negotiate down to a point where an agreement can be reached with which to proceed. But an agreement is always made based on the transformed policies.

As noted, each of the independent claims, and all claims depending therefrom, recite the claimed element, not taught or suggested by Epling, that transactions are allowed to occur between participants only if they have latching privacy-use information. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Epling and are in condition for allowance.

Rejection of Claims 1-12 under 35 U.S.C. §103(a)

On pages 3 and 4 of the Office Action, the Examiner rejected claims 1-12 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0029201 to Barzilai et al. ('Barzilia') in view of U.S. Patent No. 6,343,274 to McCollom et al. ('McCollom').

U.S. Patent Application Publication No. 2002/0029201 A1 to Barzilai et al.

U.S. Patent Application Publication No. 2002/0029201 A1 to Barzilai et al. ("Barzilai") teaches a method for controlling an exchange of information between a first party and a second party. The method includes receiving from the first party a set of one or more privacy preferences, indicating restrictions to be placed on use of specified items of the information to be disclosed by the first party, and receiving from the second party a description of a privacy policy, indicating undertakings by the second party with regard to restricting the use of the specified items of the information. The compatibility of the privacy preferences with the privacy policy is assessed. If the privacy preferences and the privacy policy are found to be incompatible, a negotiation is brokered with at least one of the first and the second parties so as to bring the privacy preferences and the

privacy policy into mutual compatibility. The information is provided from the first party to the second party only when the privacy preferences and the privacy policy are found to be compatible (Barzilai, Abstract). The Examiner acknowledges Barzilai lacks only allowing transactions to occur between participants having matching privacy-use information.

U.S. Patent No. 6,343,274 to McCollom et al.

U.S. Patent No. 6,343,274 to McCollom et al. ("McCollom") teaches providing privacy for a consumer identity and protects information concerning advertisements accessed by the consumer while still providing marketing and demographic statistics to a merchant regarding those advertisement accesses. A consumer user interface provides the consumer easy control over what advertisements the consumer is receiving and allows the consumer to easily subscribe and unsubscribe from advertisements from either particular merchants or categories of products and services. A commerce server receives the request for services from the consumer user interface program and provides the requested advertisements from specific merchants or from selected categories (McCollom, abstract). The Examiner relies on McCollom for the alleged teaching of only allowing transactions to occur between participants having matching privacy-use information.

The Examiner has not Established a *prima facie* Case of Obviousness

As set forth in the MPEP:

> To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

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As noted above, the present claimed invention focuses on improving security in an E-Marketplace for a consumer. This is accomplished, in part, by determining a consumer's privacy use information, comparing this privacy use information to those of the various vendors of the E-Marketplace, and only allowing transactions between a consumer and a vendor with matching privacy use information.

Specifically, claim 1 states the limitation of:

> "only allowing transactions to occur between participants who have matching privacy-use information"

Each additional independent claim (claims 5 and 9) state a variation of this limitation.

This limitation is a primary point of divergence between the present invention and the prior art, including Barzilai and McCollom, whether considered alone or in combination. The Examiner acknowledges Barzilai lacks only allowing transactions to occur between participants having matching privacy-use information and looks to McCollom to allegedly teach this limitation as well as provide motivation for modifying Barzilai.

McCollom deals with a system of advertising which protects both a consumer's identity and privacy. The Examiner asserts that McCollom discloses a method wherein transactions are only allowed if participants' privacy use information matches. However, the citation to McCollom the Examiner provides as support is not directed towards any transaction in which two participants' privacy use information matches. McCollom is merely a way of delivering advertising to a consumer without disclosing any of the consumer's personal information. No personal policies are checked for

matches in the system of McCollom. The merchant, or the advertiser in this case, never provides a set of privacy-use policies. The advertiser just presents a listing of advertisements for delivery to the consumer. No agreement is made between the parties, nor is any matching of privacy-use information performed between the consumer and the advertisement provider. Additionally, McCollom is not concerned with an E-Marketplace as is discussed in both the present invention and Barzilai, merely in a system of delivering advertising content. No motivation is provided in McCollom for modifying an E-Marketplace such as the one taught in Barzilai. At best, impermissible hindsight is being used to attempt to find a basis for rejecting the claimed invention under 35 U.S.C. §103. However, since fundamental teachings and/or suggestions, which would be required to make the rejections valid, are missing, the rejection of the claims must fail.

As noted, each of the independent claims, and all claims depending therefrom, recite the claimed element, not taught or suggested by Barzilai or McCollom, either alone or in combination, that transactions are allowed to occur between participants only if they have latching privacy-use information. Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Barzilai in view of McCollom and are in condition for allowance.

Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment associated with this communication to Deposit Account No. 09-0461.

Respectfully submitted

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Date

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